

The remand being entered today was not written
for publication and is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte NAOYASU MIYAGAWA et al.

Appeal No. 2004-0409
Application No. 09/460,222¹

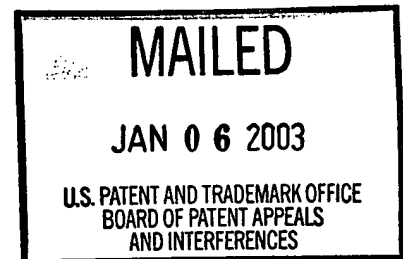
REMAND TO EXAMINER

Before HARKCOM, Acting Chief Administrative Patent Judge, WILLIAM F. SMITH and
NASE, Administrative Patent Judges.

Per curiam.

REMAND TO THE EXAMINER

The above-identified application is being remanded to the examiner for
appropriate action.



¹ Application filed December 13, 1999, for reissue of U.S. Patent No. 5,235,581 (Application No. 07/740,629, filed August 5, 1991).

BACKGROUND

1. A review of the file record indicates that claims 26, 28 to 32 and 34 to 38 have been rejected under 35 U.S.C. § 251 as attempting to recapture subject matter surrendered in the application to obtain the original patent.

2. A precedential opinion concerning a reissue recapture rejection under 35 U.S.C. § 251 was decided May 29, 2003 in Ex parte Eggert, 67 USPQ2d 1716 (Bd. Pat. App. & Int. 2003).² In Eggert, the majority opinion applied the fact-specific analysis set forth in In re Clement, 131 F.3d 1464, 1468-71 45 USPQ2d 1161, 1164-66 (Fed. Cir. 1997), determined that under the facts and circumstances before it, the “surrendered subject matter” was claim 1 of Eggert as that claim existed prior to the post-final rejection amendment that led to the allowance of claim 1 in the original patent, and decided that reissue claims 15-22 of Eggert were not precluded (i.e., barred) by the “recapture rule.” 67 USPQ2d at 1730-33, slip. op. at 39-45.

ACTION

We remand this application to the examiner for a determination of whether the rejection under 35 U.S.C. § 251 remains appropriate in view of Ex parte Eggert.

If the examiner determines that the rejection under 35 U.S.C. § 251 remains appropriate, the examiner is authorized to prepare a supplemental examiner's answer specifically addressing the § 251 rejection. See 37 CFR § 1.193(b)(1). In the event


² A copy of the Eggert slip opinion is attached to this remand. An electronic copy of Eggert is available at <http://www.uspto.gov/web/offices/dcom/bpai/prec/RC010790.pdf>.

If the examiner determines that the rejection under 35 U.S.C. § 251 is no longer appropriate, the examiner should withdraw the rejection in an appropriate Office action.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01.


GARY V. HARKCOM
Acting Chief Administrative Patent Judge


WILLIAM F. SMITH
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge

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Page 4

JAMES E LEDBETTER ESQ
STEVENS DAVIS MILLER & MOSHER L L P
1615 L STREET NW
P O BOX 34387 SUITE 850
WASHINGTON, DC 20043-4387